

REMARKS/ARGUMENT

This Amendment is being filed in response to the Office Action dated May 20, 2005. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-26 are pending in this application. Claims 1, 16, and 26 are independent claims. The claims were amended herein to be in better U.S. form. These amendments were not performed for purposes of patentability and therefore each of the claims should have a full range of equivalents under the Doctrine of Equivalents.

In the Office Action, Claims 1, 2, 8-12, 16, 17, and 26 are rejected under 35 U.S.C. §102(b) as anticipated by Japanese Patent Application 10-234,016 to Kazue ("Kazue"). Claims 3-5, 18, 19, and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kazue in view of U.S. Patent No. 6,408,266 to Oon ("Oon"). Claims 6 and 21 are rejected under 35 U.S.C. §103(a) as unpatentable over Kazue. Claims 7 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kazue in view of U.S. Patent No. 6,002,997 to Tou ("Tou"). Claims 13-15 and 23-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kazue in view of U.S. Patent No. 5,543,851 to Chang ("Chang").

Kazue shows a system for translating closed caption text (see, Paragraph 48) into another language for display with image data (Paragraphs 11-14).

However, Kazue clearly does not disclose or suggest (emphasis provided) "sequentially analyzing portions of said text data in an original language in which said text data is received; sequentially translating said portions of text data in accordance with a variable level of complexity of translation to a target language; and displaying said portions of translated text data while simultaneously playing the audio/video signal that is temporally related to each of the portions" as required by Claim 1 and as substantially required by each of Claims 16 and 26.. Kazue merely translates the closed captioned text into a language of the user (see, Paragraph 49).

It is noted that the Office Action recognizes that Kazue does not show setting a level of complexity of translation but cites Chang for showing this feature (see, Office Action, Pages 10-11, Numbered Paragraph 6). It is respectfully submitted that this reliance on Chang is misplaced.

Chang shows selecting closed captioned text that has an identifier greater than a preselected threshold value and in an original language for translation into another language. In other words, Chang shows that only words in the original language that

have a given threshold value will be selected for translation. This threshold value is a flag that represents a degree of difficulty of the word in the original language (see, Chang, Col. 4, lines 27-38). The operation of this threshold value is shown in detail in FIG. 5b, blocks 521, 522, 524, and 526 and described in detail in the accompanying text in Col. 5, line 59 through col. 6, line 6. As is clear therein, the system of Chang when operating in an automatic mode, retrieves an identifier (block 521), determines if any identifier value of closed captioned text is equal or greater than a level (block 522), and if so, specific closed captioned text with an identifier equal or greater than the level (block 524) is translated (block 526). For closed captioned text that has an identifier below the level, the system proceeds to provide the text to the user to see if they want to select any particular text for translation (see, blocks 510, 512, 514, and 516).

As is made clear by Chang, the level of complexity indicated is of the closed captioned text, not a "variable level of complexity of translation to a target language" as required by Claim 1 and as substantially required by each of Claims 16 and 26. Accordingly, it is respectfully submitted that Claims 1, 16, and 26 are allowable over Kazue alone or in combination with Chang and an indication to that effect is respectfully requested. Claims 2-15,

and 17-25 respectively depend from one of Claims 1 and 16 and are allowable for at least that reason as well as for the separately patentable elements respectively contained in each of the dependent claims. Accordingly, separate consideration and allowance of Claims 2-15 and 17-25 over Kazue alone or in combination with Chang is respectfully requested.

In addition, it is respectfully submitted that the Office Action does not make any proper showing of why a person of ordinary skill in the art would combine Kazue with any of the other prior art references. It is not sufficient to state that the modification is, in effect, an improvement (e.g., would be less repetitious (see, Office Action, Page 7, Paragraph 3); make the translation process more accurate (see, Office Action, Page 9, Paragraph 4); more polished and accurate (see, Office Action, Page 10, Paragraph 5); or learn language at a gradual pace (see, Office Action, Page 10-11, Paragraph 6) and therefore is obvious.

In response to the above rejections noted rejections utilizing Kazue in combination with other art, the following general remarks are presented as applicable for each.

It is respectfully submitted that for each of the above rejection, the Office Action cites a motivation to make combinations of references that finds no support in any of the numerous cited references. Where is this desirability to combine

references suggested from the references themselves or obvious to a person of ordinary skill in the art?.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1442, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art of knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

When determining obviousness, "[t]he factual inquiry whether to combine references must be thorough and searching." **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ 1430, 1433 (Fed. Cir. 2002), **citing McGinley v. Franklin Sports, Inc.**, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "It must be based on objective evidence of record." **Id.** "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 1000, 50 USPQ2d at 1617, **citing McElmurry v.**

Ark. Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

The suggestion in the Office Action that the combinations of prior art references "would be obvious to one having ordinary skill in the art ... " is respectfully refuted. One may not utilize the teachings of the present application as a road map to pick and choose amongst prior art references for the purposes of attempting to arrive at the presently disclosed invention. The Federal Circuit has identified three possible sources for motivation to combine references including the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. (See, *In re Rouffet*, U. S. Court of Appeals Federal Circuit, U.S.P.Q. 2d, 1453, 1458.) There must be a specific principle that would motivate a skilled artisan, with no knowledge of the present invention, to combine the prior art as suggested in the Office Action. The use of hindsight in the selection of references is forbidden in comprising the case of obviousness. Lacking a motivation to combine references, a proper case of obviousness is not shown (see, *In re Rouffet*, 1458).

The U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. § 103(a) in the *In re Rouffet*, holding. The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hind sight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct **the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art,

the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.

The Examiner's reasoning for the motivation, namely, that those skilled in the art would have been motivated to combine Kazue with the other prior art, could only have been made with hindsight based on the teachings of the present disclosure. The Examiner's reasoning for the motivation for combining the references is nowhere recognized in the prior art nor does the Examiner attempt to make any showing that the art recognized such problems.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Thus, Applicants again respectfully submit that the Examiner has used impermissible hindsight to reject the claims under 35 U.S.C. § 103(a). As discussed above, the Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

The mere fact that the prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); and *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

How can the Office Action espouse that this reconstruction forwarded does not include knowledge gleamed only from the applicants' disclosure? If this reconstruction did not come from the present application, where did it come from? The above reconstruction certainly did not come from the prior art. Even the

Office Action does not point to any portions of the prior art for teaching the suggestion reconstructions/modification as pointed out above.

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that "to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction - an illogical and inappropriate process by which to determine patentability." (Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996)). "To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997)). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the

invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited references omitted).'" (In re Kotzab, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000)).

The applicants respectfully maintain that there is no suggestions in the prior art references to make the combinations in the manner proposed by the Examiner to achieve the applicants' claimed invention.

The Examiner is requested to consider MPEP 2143, wherein it is stated:

"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." And, "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS ... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a prior art device "may be capable of being modified to run the way the apparatus is

claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.)." It is respectfully submitted that the Office Action has not met the burden of establishing a suggestion to combine references.

In fact in several cases the Examiner has not even shown a reference but has resorted to taking Official Notice of elements that are not identified even in a prior art reference. The MPEP in §2144.03 in a section titled 'Reliance on Common Knowledge in the Art or "Well Known" Prior Art' makes clear that only in limited circumstances is it appropriate for an examiner to take official notice of facts not in the record or to rely on "common knowledge" in making a rejection and that such rejections should be judiciously applied. MPEP in §2144.03(A) is entitled "Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support The Examiner's Conclusion". Therein it states that (emphasis provided) "Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While 'official notice' may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as

being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)) ... Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to 'fill in the gaps' which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21

... In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ('[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.').

It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ... As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. Id. at 1385, 59 USPQ2d at 1697. See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) ... "The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies."

Accordingly, the Applicants respectfully traverse the Office Actions taking of Official Notice for "it is old and well-known in the art of general learning/instruction to manually increase the difficulty level of whatever is being learned ..." (For example, see, Office Action, page 11-12, last paragraph.) It is

respectfully requested that the Examiner produce such a reference so that the Applicants may review and refute this assertion.

It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, that none of the suggested combinations of prior art utilized to reject each of Claims 1-26 finds proper motivation for combination. Further, since the Office Action acknowledges that the prior art alone does not show the claimed features, it is respectfully submitted that Claims 1-26 are allowable for this additional reason and an indication to that effect is respectfully requested.

Further, it is respectfully submitted that none of the prior art reference even in combination with Kazue disclose or suggest "wherein said text data is speech-to-text transcriptions or OCR-ed superimposed text present in said video component" as required by Claim 8 (Kazue merely operates on closed captioned text); nor "determining where a term present in said portion of text data under analysis is repeated and if the term is determined to be repeated, replacing the term with a different term of similar meaning in all occurrences after a first occurrence of the term" as required by Claim 3 (Oon is cited for showing a synonym which it is asserted is the same as this feature, though it is not because the

synonym is shown for each character string retrieved. Oon makes clear that it fetches each character string or word one at a time and does not search for other occurrences of words).

In addition, the Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of the above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Early and favorable action is earnestly solicited.

Respectfully submitted,

By Gregory L. Thorne

Gregory L. Thorne, Reg. 39,398
Attorney for Applicant(s)
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THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101

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